REMARKS

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered.

In order to place the application in condition for allowance, or alternately in better condition for appeal, claims 10-14 have been cancelled without prejudice. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Rejections

Rejection Under 35USC §103

Claims 1-16 and 30-33 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0184240 to Volkoff et al. ("Volkoff") in view of U.S. patent 6,507,857 to Yalcinalp ("Yalcinalp"). Applicant respectfully traverses the rejection and request reconsideration

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 2-9 and 32-33, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Previously presented) A workflow management device comprising:
a communications interface configured to receive a user request comprising one or more user-desired product properties associated with a user-desired product, the interface further configured to communicate with one or more workflow processing devices located external of the workflow management device;
a storage device configured to store predefined rules data for processing the user request; and
processing circuitry configured to process the user request using the predefined rules data to produce a transformed user request without communicating with the one or more workflow processing devices, the transformed user request including information for automatically organizing workflow among the one or more workflow processing devices in accordance with the one or more user-desired product properties so as to achieve the user-desired product." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

With regard to the limitation of the processing circuitry, the Office admits that the Volkoff reference "is silent with respect to a main or central processor section configured to process the request using the predefined rules data and wherein the transformation is done without communicating with one or more workflow processing devices".

However, the Office states that the Yalcinalp reference discloses that "the transformation is done without communicating with one or more workflow processing devices" (Final Office Action, p.4). Applicant respectfully disagrees. To begin with, the Office appears to equate application server 104 of the Yalcinalp reference to computer server 104 of Applicant's invention. However, the application server 104 is the only device disclosed in the Yalcinalp

reference, whereas Applicant's computer server 104 is only one component of a workflow management <u>system</u> 100 (Fig. 1) that also includes <u>plurality</u> of devices including a workflow controller 106, and, importantly, workflow processing devices 110,112,114 for preprocessing, printing, and finishing printed output. The absence from the Yalcinalp reference of any workflow processing devices is significant because the Office contends that the Yalcinalp reference teaches or suggests the limitation of Applicant's invention that the user request is processed without communicating with one or more workflow devices. However, the Yalcinalp reference does not disclose <u>any</u> workflow devices, nor any other such interconnected devices with which the application server 104 interoperates to <u>achieve a user-desired product</u>. The Office, in essence, uses the total absence from the reference of the disclosure of any such devices to support its contention that the reference teaches that the user request is processed without communicating with one or more workflow processing devices that don't exist. If a reference does not disclose the existence of any such devices, then of course it will not disclose that there is any communication with the devices that don't exist. Such circular logic is insufficient to support a proper rejection. Applicant believes that for a rejection to be proper, the Yalcinalp reference would first have had to disclose the existence of a workflow processing device, and then disclose that the user request is processed using the predefined rules data to produce a transformed user request <u>without communicating with the one or more workflow processing devices</u>.

In addition, the Office fails to consider all the words of limitation of the processing circuitry element. The limitation further recites that the transformed user request includes information for automatically organizing workflow among the one or more workflow processing devices. Because no device other than the application server 104, and in particular no workflow processing devices, are disclosed by the Yalcinalp reference, it follows that any transformed user request produced by the application server 104 of the Yalcinalp reference <u>cannot include information for automatically organizing workflow among the one or more workflow processing devices</u>.

Furthermore, it is noted that while the Yalcinalp reference does not disclose any such workflow processing hardware devices, it does disclose <u>software components 225</u> that are external to the XSLT processor 205 (Fig. 2). The Yalcinalp reference discloses that a:

"method of creating a transform document using a style sheet comprises the steps of receiving a request for an input document, retrieving the style sheet, having tags, associated with the input document, wherein one of the tags represents an external component, processing the tags, including one tag representing an external component, in the style sheet to generate a transform document, and processing a method associated with the external component. An additional step of placing the results of processing the method associated with the external component in the transform document may be performed. ... The step of processing the method associated with the external component may include loading the external component in an XSLT processor and <u>initiating the execution of the method associated with the external component</u>." (col. 2, lines 25-42; emphasis added)

Accordingly, the transformed user request is produced by the XSLT processor <u>communicating with</u> the external components 225. Therefore, to any extent that the components 225 external to the XSLT processor 205 are considered analogous to the workflow processing devices of Applicant's invention, the Yalcinalp reference fails to teach that the transformed user request is produced without communicating with the external components, as required by the limitations of Applicant's claim 1.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicant's claim limitations.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. With regard to motivation, the Office stated that a "skilled artisan would have been motivated to combine as suggested by Yalcinalp by providing the ability to define components in a particular style sheet in order to execute different methods outside a particular application" (Final Office Action, p.4). Applicant respectfully believes that the stated motivation is merely a conclusory statement of generalized advantages that may be offered by the Yalcinalp reference. Applicant believes that this is too vague and not specific enough to ascertain a motivation in one

or the other for combining. Consequently, using these overly broad statements to create Applicant's claim limitation impermissibly uses the Applicant's disclosure as a blueprint or in hindsight for the rejection.

In addition, the Volkoff reference executes different methods outside a particular application in communicating with external workflow processors 80 (Figs. 3,4) to produce a transformed user request (i.e. a modified branch of a job ticket 61) (para. [0039]-[0040]). Therefore, the combined references teach away from the limitation recited in claim 1 wherein the transformed user request is produced without communicating with the workflow processing devices.

Accordingly, there is no suggestion or motivation to modify the reference or to combine reference teachings.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Independent claims 15, 20, 30, and 31 each recite limitations similar to those of claim 1, discussed above, including the limitation of "without communicating with one or more workflow processing devices". For similar reasons as explained heretofore with regard to claim 1, therefore, the features of the present invention are not taught or suggested by the cited references in that at least these features are neither taught nor suggested by the cited references in combination, and the references cannot be properly combined. Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection of independent claims 15, 20, 30, and 31, and their corresponding

dependent claims 16-19 and 21-26, is improper at least for that reason and should be withdrawn.

Dependent claim 32 is further patentably distinguishable over the cited references. Claim 32 recites:

"32. (Previously presented) The device of claim 9, wherein <u>each stylesheet corresponds to a different subset of the product properties.</u>" (emphasis added)

In rejecting claim 32, the Office states that "the combination of Volkoff in view of Yalcinalp teaches wherein each stylesheet corresponds to a different subset of the product properties (Figure 2, all features, wherein the style sheet corresponds with the XSLT processor components, Yalcinalp)" (Final Office Action, p.12). Fig. 2 of the Volkoff reference "is a node tree diagram … 10 that illustrates processes defined in a job ticket for printing a brochure". (para. [0028]). However, it is evident from Fig. 2 of the Yalcinalp references that stylesheets 220 are different elements than components 225. With regard to different stylesheets 220, the Yalcinalp reference teaches merely that a user requests a document having an associated style sheet (Fig. 3, step 300). There is no teaching or suggestion that each of the associated style sheets 220 corresponds to a different subset of product properties of the user request. Such an interpretation impermissibly relies on hindsight and uses the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 32 is improper for this additional reason.

. Dependent claim 33 is further patentably distinguishable over the cited references. Claim 33 recites:

"33. (Previously presented) The device of claim 32, <u>wherein the transformed user request generated by a first one of the stylesheets has a different workflow than the transformed user request generated by a second one of the stylesheets.</u>" (emphasis added)

In rejecting claim 33, the Office states that the "document request and transformed document is generated through the components contained in the XSLT processor which includes validation, XML parser, stylesheet and external component processing and XML document builder" (Final Office Action, p.12-13). To whatever extent this is accurate, however, the Office

points out nothing in the references that teaches or suggests that the transformed user request generated by a first one of the stylesheets has a different workflow than the transformed user request generated by a second one of the stylesheets. Any such interpretation impermissibly relies on hindsight and uses the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 33 is improper for this additional reason.
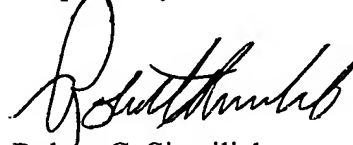
Conclusion

Attorney for Applicant has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,

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